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EXAMINER

CASCA, FRED A

ART UNIT PAPER NUMBER

2687

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/788,533

Applicant(s)

MAJOR, HARRY RICHMOND

Examiner

Fred A. Casca

Art Unit

2687

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/18/04</u> .  | 6) <input type="checkbox"/> Other: ____.                                    |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 4-5, 7-8, 12, 15, 17-18, 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hinds et al (U.S. Publication No. US 2005/0037755 A1), in view of Deeds (US Publication No. 2004/0203610 A1).

Referring to claim 1, Hind discloses in a mobile communication device, a method of delivering an e-mail message through a wireless communication network (Abstract, and paragraph 3, "wireless e-mail") comprising the acts of:

receiving through a user interface, e-mail message information corresponding to a new e-mail message to be delivered (Figure 2, paragraphs 13, and 30-32, "mobile station 115", "keyboard", "display", note that mobile station operating in a GPRS system comprises email functionalities and hence receives through a user interface, e-mail message information corresponding to a new e-mail message to be delivered );

identifying whether a data communication service for communicating e-mail messages is available (paragraphs 13-14, and 23-25, "GPRS", "determine which network provides the best communication services", note that a qualified network is determined inherently through identifying the networks. Further note that GPRS-capable vs. GSM-only networks are

considered, hence it is inherent that whether a data communication service for communicating e-mail messages is available is identified);

causing the e-mail message information to be sent via the data communication service based on the data communication service being available (paragraphs 13-14, and 23-25, "GPRS", note that a GPRS-capable system is identified which inherently provides e-mail message information to be sent via the data communication service based on the data communication service), and cause the message reformation to be sent in a short message service (SMS) message (paragraphs 14, and 23-25, "SMS", note that the an SMS method is included. Further note that the mobile device is capable of selecting a voice-only network, which is inherently referred to a GSM-only system, hence the mobile station sends SMS when communicating with a non-GPRS network).

Hind does not specifically disclose **otherwise**, causing the **e-mail** message reformation to be sent in a short message service (SMS) message **via an SMS-to-email service based on the data communication service being unavailable**.

Deeds disclose a method of creating and transmitting text messages, where SMS-to-email is used to convert SMS messages into e-mail messages (paragraphs 0059, and 0061, "SMS message to be converted into an E-mail").

It would have been obvious to one of the ordinary skill in the art at the time of the invention to modify the device of Hind by incorporating the teachings of Deeds into that of Hind, and providing the device of Hind to identify and voice (non-GPRS) networks and use SMS-to-Email in such networks, for the purpose of allowing mobile stations to communicate with e-mail format messages within voice-only networks, and consequently providing convenience for users.

Referring to claim 4, the combination of Hinds/Deeds disclose the method of claim 1, and further disclose prior to causing the e-mail message information to be sent in the SMS message, formatting the e-mail message information in an SMS-to-Email message format compatible with the SMS-to-Email service (Deeds, paragraphs 0059, and 0061, “SMS message to be converted into an E-mail”).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to modify the device of Hind by incorporating the teachings of Deeds into that of Hind, for the purpose of allowing communication data to be handled by the network appropriately.

Referring to claims 5 and 22, the combination of Hinds/Deeds disclose the method and computer product of claim 1 and 18, and further disclose the data communication service comprises a data packet service (Hinds, paragraphs 13-14, and 23).

Referring to claims 7 and 17, the combination of Hinds/Deeds disclose the method and device of claims 1 and 12, and further disclose the data communication service operates in accordance with a 3<sup>rd</sup> Generation (3G) compatible standard (Hinds, paragraphs 6, and 9, “3<sup>rd</sup> Generation”).

Referring to claim 8, the combination of Hinds/Deeds disclose the method of claim 1, and further disclose the act of identifying whether a data communication service for communicating

e-mail messages is available is based on detecting whether a current wireless network makes the data communication service available (Hinds, paragraphs 14, and 24-25).

Referring to claim 12, Hind discloses a mobile communication device (figure 2, paragraph 16, “mobile communication device”), comprising:

a receiver (figure 2, and paragraphs 30-32, “receiver”);

a transmitter (figure 2, and paragraphs 30-32, “transmitter”);

a user interface (figure 2, and paragraphs 30-32, “display”, “keyboard”);

one or more processors coupled to the receiver, the transmitter, and the user interface (figure 2, and paragraphs 30-32, “Microprocessor”); and

the one or more processors being operative to receive, through the user interface, e-mail message information corresponding to a new e-mail message to be delivered (Figure 2, paragraphs 13, and 30-32, “mobile station 115”, “keyboard”, “display”, note that mobile station operating in a GPRS system comprises email functionalities and hence receives through a user interface, e-mail message information corresponding to a new e-mail message to be delivered);

identify whether a packet data service for communicating e-mail messages is available to the mobile communication device (paragraphs 13-14, and 23-25, “GPRS”, “determine which network provides the best communication services”, note that a qualified network is determined inherently through identifying the networks. Further note that GPRS-capable vs. GSM-only networks are considered, hence it is inherent that whether a data communication service for communicating e-mail messages is available is identified);

cause the e-mail message information to be transmitted via the packet data service based on the packet data service being available (paragraphs 13-14, and 23-25, "GPRS", note that a GPRS-capable system is identified which inherently provides e-mail message information to be sent via the data communication service based on the data communication service);

cause the message reformation to be sent in a short message service (SMS) message (paragraphs 14, and 23-25, "SMS", note that the an SMS method is included. Further note that the mobile device is capable of selecting a voice-only network, which is inherently referred to a GSM-only system, hence the mobile station sends SMS when communicating with a non-GPRS network).

Hind does not specifically disclose **otherwise**, causing the **e-mail** message reformation to be sent in a short message service (SMS) message **via an SMS-to-email service based on the data communication service being unavailable**.

Deeds disclose a method of creating and transmitting text messages, where SMS-to-email is used to convert SMS messages into e-mail messages (paragraphs 0059, and 0061, "SMS message to be converted into an E-mail").

It would have been obvious to one of the ordinary skill in the art at the time of the invention to modify the device of Hind by incorporating the teachings of Deeds into that of Hind, and providing the device of Hind to identify and voice (non-GPRS) networks and use SMS-to-Email in such networks, for the purpose of allowing mobile stations to communicate with e-mail format messages within voice-only networks, and consequently providing convenience for users.

Referring to claim 15, the combination of Hinds/Deeds disclose the method of claim 12, and further disclose the one or more possessors being further operative to format the e-mail message information in an SMS-to-email message format compatible with the SMS-to-email service prior to causing the e-mail message information to be transmitted in the SMS message (Deeds, paragraphs 0059, and 0061, "SMS message to be converted into an E-mail").

It would have been obvious to one of the ordinary skill in the art at the time of the invention to modify the device of Hind by incorporating the teachings of Deeds into that of Hind, for the purpose of allowing communication data to be handled by the network appropriately.

Referring to claim 18, Hinds discloses a computer program product (figure 2, paragraph 16, "mobile communication device") comprising:

a computer instruction storage medium (figure 2, and paragraphs 30-32, "Microprocessor", "RAM");

computer instructions stored in the computer instruction storage medium (figure 2, and paragraphs 30-32, "Microprocessor", "RAM", note that a CPU inherently operates on instructions in a storage medium);

the computer instructions being executable on a processor for receiving through a user interface, e-mail message information corresponding to a new e-mail message to be delivered (Figure 2, paragraphs 13, and 30-32, "mobile station 115", "keyboard", "display", note that mobile station operating in a GPRS system comprises email functionalities and hence receives through a user interface, e-mail message information corresponding to a new e-mail message to be delivered);



identifying whether a data communication service for communicating e-mail messages is available (paragraphs 13-14, and 23-25, "GPRS", "determine which network provides the best communication services", note that a qualified network is determined inherently through identifying the networks. Further note that GPRS-capable vs. GSM-only networks are considered, hence it is inherent that whether a data communication service for communicating e-mail messages is available is identified);

causing the e-mail message information to be sent via the data communication service based on the data communication service being available (paragraphs 13-14, and 23-25, "GPRS", note that a GPRS-capable system is identified which inherently provides e-mail message information to be sent via the data communication service based on the data communication service); and

cause the message reformation to be sent in a short message service (SMS) message (paragraphs 14, and 23-25, "SMS", note that the an SMS method is included. Further note that the mobile device is capable of selecting a voice-only network, which is inherently referred to a GSM-only system, hence the mobile station sends SMS when communicating with a non-GPRS network).

Hind does not specifically disclose **otherwise**, causing the **e-mail** message reformation to be sent in a short message service (SMS) message **via an SMS-to-email service based on the data communication service being unavailable**.

Deeds disclose a method of creating and transmitting text messages, where SMS-to-email is used to convert SMS messages into e-mail messages (paragraphs 0059, and 0061, "SMS message to be converted into an E-mail").

It would have been obvious to one of the ordinary skill in the art at the time of the invention to modify the device of Hind by incorporating the teachings of Deeds into that of Hind, and providing the device of Hind to identify and voice (non-GPRS) networks and use SMS-to-Email in such networks, for the purpose of allowing mobile stations to communicate with e-mail format messages within voice-only networks, and consequently providing convenience for users.

Referring to claim 21, the combination of Hinds/Deeds disclose the computer program product of claim 18, and further disclose the computer instructions being further executable on a processor for formatting the e-mail message information in an SMS-to-Email message format compatible with the SMS-to-Email service prior to causing the e-mail message information to be sent in the SMS message (Deeds, paragraphs 0059, and 0061, "SMS message to be converted into an E-mail").

It would have been obvious to one of the ordinary skill in the art at the time of the invention to modify the device of Hind by incorporating the teachings of Deeds into that of Hind, for the purpose of allowing communication data to be handled by the network appropriately.

Referring to claim 23, Hinds discloses a method of delivering an e-mail message through a wireless communication network (Abstract, and paragraph 3, "wireless e-mail") comprising the acts of identifying whether a packet data service for communicating e-mail messages is available (paragraphs 13-14, and 23-25, "GPRS", "determine which network provides the best communication services", note that a qualified network is determined inherently through identifying the networks. Further note that GPRS-capable vs. GSM-only networks are

considered, hence it is inherent that whether a data communication service for communicating e-mail messages is available is identified); and causing a newly drafted e-mail message to be sent (paragraphs 13-14, and 23-25, "GPRS", note that a GPRS-capable system is identified which inherently provides e-mail message information to be sent via the data communication service based on the data communication service).

Hinds does not specifically disclose causing a newly drafted e-mail message to be sent **in a short message service (SMS) message via an SMS-to-Email service based on the packet data service being unavailable.**

Deeds disclose a method of creating and transmitting text messages, where SMS-to-email is used to convert SMS messages into e-mail messages (paragraphs 0059, and 0061, "SMS message to be converted into an E-mail").

It would have been obvious to one of the ordinary skill in the art at the time of the invention to modify the device of Hind by incorporating the teachings of Deeds into that of Hind, and providing the device of Hind to identify and voice (non-GPRS) networks and use SMS-to-Email in such networks, for the purpose of allowing mobile stations to communicate with e-mail format messages within voice-only networks, and consequently providing convenience for users.

Referring to claim 24, the combination of Hinds/Deeds disclose the method of claim 23, and further disclose causing the newly drafted e-mail message to be sent via the packet data service based on the packet data service being available (Hinds, paragraphs 13-14, and 23-25, "GPRS", note that a GPRS-capable system is identified which inherently provides e-mail

message information to be sent via the data communication service based on the data communication service).

3. Claims 2, 13, 19, and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hinds et al (U.S. Pub. No. US 2005/0037755 A1), in view of Deeds (US Pub. No. 2004/0203610 A1), and further in view of Miramontes (U.S. Pub. No. 2004/0147278 A1)

Referring to claims 2, 13, and 19, the combination of Hinds/Deeds disclose the method and program product of claims 1, 12, and 18.

The combination of Hinds/Deeds does not disclose the user interface comprises a graphical user interface (GUI) of the mobile communication device.

Miramontes discloses an electronic device for text messaging where GUI (Graphical User Interface) is used as user interface (paragraphs 15, “graphical user interface”).

It would have been obvious to one of the ordinary skill in the art at the time of invention to modify the method and product of Hinds/Deeds by incorporating the teachings of Miramontes into that of Hinds/Deeds because a GUI interface would allow the user to navigate on the display unit make selections smoothly and conveniently.

Referring to claim 25, the combination of Hinds/Deeds disclose the method claim 23. The combination of Hinds/Deeds does not disclose user interface (GUI).

Miramontes discloses an electronic device for text messaging where GUI (Graphical User Interface) is used as user interface (paragraphs 15, “graphical user interface”).

It would have been obvious to one of the ordinary skill in the art at the time of invention to modify the method and product of Hinds/Deeds by incorporating the teachings of Miramontes into that of Hinds/Deeds because a GUI interface would allow the user to navigate on the display unit make selections smoothly and conveniently.

Referring to claim 26, the combination of Hinds/Deeds disclose the method of claim 23, and further disclose receiving e-mail message information corresponding to the newly drafted e-mail message to be delivered (Hinds, Figure 2, paragraphs 13, and 30-32, "mobile station 115", "keyboard", "display", note that mobile station operating in a GPRS system comprises email functionalities and hence receives through a user interface, e-mail message information corresponding to a new e-mail message to be delivered); and formatting the e-mail message information in an SMS-to-Email message format compatible with the SMS-to-Email service prior to causing the e-mail message information to be sent in the SMS message (Deeds, paragraphs 0059, and 0061, "SMS message to be converted into an E-mail").

It would have been obvious to one of the ordinary skill in the art at the time of the invention to modify the device of Hind by incorporating the teachings of Deeds into that of Hind, for the purpose of allowing communication data to be handled by the network appropriately.

The combination of Hinds/Deeds does not disclose receiving, **through a graphic user interface IGUI**, e-mail message information.

Miramontes discloses an electronic device for text messaging where GUI (Graphical User Interface) is used as user interface (paragraphs 15, "graphical user interface").

It would have been obvious to one of the ordinary skill in the art at the time of invention to modify the method and product of Hinds/Deeds by incorporating the teachings of Miramontes into that of Hinds/Deeds because a GUI interface would allow the user to navigate on the display unit make selections smoothly and conveniently.

4. Claims 3, 6, 9-11, 14, 16, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Publication No. US 2005/0037755 A1 (Hinds et al.), in view of well known prior art (MPEP 2144.03).

Referring to claims 6 and 16, the combination of Hinds/Deeds disclose method and device of claims 1 and 12.

The combination of Hinds and Deeds does not disclose the data communication service operates in accordance with a 2.5 Generation (2.5G) compatible standard.

The examiner takes official notice of the fact that 2.5 Generation (2.5G) compatible standard is well known in the art is widely used in communication systems around the world.

It would have been obvious to one of the ordinary skill in the art at the time of the invention to provide the method and device of Hinds/Deeds by providing a 2.5G standard communication system for the purpose of allowing voice and data (GSM and GPRS) networks to integrate smoothly and consequently provide a system capable of handling email and SMS in the same network.

Referring to claim 9, the combination of Hinds/Deeds disclose method of claim 1.

The combination of Hinds and Deeds does not disclose the e-mail message information comprises an e-mail message body of text.

The examiner takes official notice of the fact that it is well known in the art the e-mail message information comprises an e-mail message body of text.

It would have been obvious to one of the ordinary skill in the art at the time of the invention to provide the method of Hinds/Deeds by providing e-mail message body of text to email message information for the purpose of allowing the receiving subscriber to immediately see the important contents of the email message.

Referring to claim 10, the combination of Hinds/Deeds disclose method of claim 1.

The combination of Hinds and Deeds does not disclose the e-mail message information comprises an e-mail destination address.

The examiner takes official notice of the fact that it is well known in the art that the e-mail message information comprises an e-mail destination address.

It would have been obvious to one of the ordinary skill in the art at the time of the invention to provide the method of Hinds/Deeds by providing e-mail message information to comprise an e-mail destination address because the message then would know what destination to transmit to.

Referring to claim 11, the combination of Hinds/Deeds disclose method of claim 1.

The combination of Hinds and Deeds does not disclose the e-mail message information comprises an e-mail subject line.

The examiner takes official notice of the fact that it is well known in the art that the e-mail message information comprises an e-mail subject line.

It would have been obvious to one of the ordinary skill in the art at the time of the invention to provide the method of Hinds/Deeds by providing e-mail message information to comprise an e-mail subject line because the message then would allow the receiving subscriber to know what the subject matter of the message is before opening it.

Referring to claims 3 and 14 and 20, the combination of Hinds/Deeds disclose method, device and product of claims 1, 12, and 18.

The combination of Hinds and Deeds does not disclose the SMS-to-Email service comprises the further act of causing the SMS message to be sent to a telephone number of the SMS-to-Email service.

The examiner takes official notice of the fact that sending text messages to the telephone number of a subscriber is well known in the art is widely used in communication systems around the world.

It would have been obvious to one of the ordinary skill in the art at the time of the invention to provide the method, device, and product of Hinds/Deeds by providing sending text messages to the telephone number of a subscriber for the purpose of allowing the sender to perform the process without looking up an e-mail address for the desired party.



*Conclusion*

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Guggisberg, U.S. Publication No. 2004/0029598 A1 discloses a method and system of transmitting short messages.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred A. Casca whose telephone number is (571) 272-7918. The examiner can normally be reached on Monday through Friday from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester Kincaid, can be reached at (571) 272-7922. The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
LESTER G. KINCAID  
SUPERVISORY PRIMARY EXAMINER